UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,433	11/13/2000	Jeff Stewart	424992000200	4323

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HOFFMAN WARNICK & D'ALESSANDRO, LLC
75 STATE STREET
14TH FL
ALBANY, NY 12207

EXAMINER
CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/709,433	STEWART ET AL.
	Examiner	Art Unit
	Joshua D. Campbell	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *25 May 2005*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *12-31* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *12-31* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Request for continued examination
05/25/2005.

2.   Claims 12-31 are pending in this case. Claims 12, 17, 20, 24, 28, 29, and 31 are
independent claims. Claims 12, 15-20, 23, 24, and 31 have been amended.

Claim Rejections - 35 USC § 103

3.   The text of those sections of Title 35, U.S. Code not included in this action can
be found in a prior Office action.

4.   Claims 12-27 and 29-31 remain rejected under 35 U.S.C. 103(a) as being
unpatentable over Adamske et al. (US Patent Number 6,625,234, filed on May 11,
1999).

Regarding independent claim 12, Adamske discloses a method in which a user
uses software on a client device to generate a print file based on a document and a
configuration file which are used at the server to create the final hardcopy document
(column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file
and configuration information to the server (column 5, line 64-column 7, line 15 of
Adamske). Adamske does not directly disclose in this embodiment that a preview is
generated by the server and provided to the user based on the print file that was
uploaded. However, Adamske discloses an alternate method in which the server
generates a preview based on the final hard-copy version generated from a print file

and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Regarding dependent claim 13, Adamske discloses a method in which a print drive is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of Adamske).

Regarding dependent claim 14, Adamske discloses a method in which a print driver is installed on the client and a print file is generated using the print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

Regarding dependent claim 15, Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske).

Regarding dependent claim 16, Adamske discloses a method in which styles

and printing options for the document are obtained and shown via the preview, which is

then provided to the client (column 5, line 64-column 7, line 56 of Adamske).

Regarding independent claim 17, Adamske discloses a method in which a print

file based on a document is uploaded to a server along with configuration information

for the document (column 5, line 64-column 7, line 15 of Adamske). A plurality of copies

is printed in accordance with a plurality of addresses that are obtained from the user

(column 5, line 64-column 7, line 15 of Adamske). A coversheet (memo) is customized

for each address and recipient is printed; at point all parts are delivered to the delivery

addresses (column 7, lines 16-56 of Adamske). Adamske does not disclose that the

customized memo is obtained from the client. However, it would have been obvious to

one of ordinary skill in the art at the time the invention was made to have allowed the

user to create the custom memo on the client rather than the server because it would

have provided the user with more freedom of customization with the memo.

Regarding dependent claim 18, Adamske discloses a method in which the

server generates the print file and then from that print file and the configuration

information provided the server generates and provides a preview to the user ().

Adamske also discloses a method in which a user interface is generated that may be

web based (on the server) (column 5, line 64-column 7, line 15 of Adamske). The

interface provides a preview section and a printing options section that allows a user to

provide configuration information (i.e. style options) (column 5, line 64-column 7, line 56

of Adamske). The interface is provided to the user via the Internet for display (column

2, lines 4-60 of Adamske). Adamske also discloses a method in which styles and printing options for the document are obtained and shown via the preview, which is then provided to the client (column 7, lines 16-56 of Adamske).

Regarding dependent claim 19, Adamske discloses a method in which a print drive is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a print driver is installed on the client and a print file is generated using the print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

Regarding independent claim 20 and dependent claims 21-23, the claims incorporate substantially similar subject matter as claims 12-15. Thus, the claims are rejected along the same rationale as claims 12-15.

Regarding independent claim 24, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a configuration file which are used at the server to create the final hardcopy document (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file and configuration information to the server, at which point the document is printed and

assembled based on configuration and style options (column 5, line 64-column 7, line

15 of Adamske). Adamske does not directly disclose in this embodiment that a preview

is generated by the server and provided to the user based on the print file that was

uploaded. However, Adamske discloses an alternate method in which the server

generates a preview based on the final hard-copy version generated from a print file

and the configuration information and provides that preview to the user for display at the

client device (column 5, line 64-column 7, line 15 of Adamske). It would have been

obvious to one of ordinary skill in the art to combine the two methods of Adamske

because it would have allowed the client system to do less work in the process.

Regarding dependent claim 25, Adamske discloses a method in which a print

file based on a document is uploaded to a server along with configuration information

for the document (column 5, line 64-column 7, line 15 of Adamske). A plurality of copies

is printed in accordance with a plurality of addresses that are obtained from the user

(column 5, line 64-column 7, line 15 of Adamske). A coversheet (memo) is customized

for each address is printed; at point all parts are delivered to the delivery addresses

(column 7, lines 16-56 of Adamske). Adamske does not disclose that the customized

memo is obtained from the client. However, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to have allowed the user to

create the custom memo on the client rather than the server because it would have

provided the user with more freedom of customization with the memo.

Regarding dependent claim 26, Adamske discloses a method in which

payment information is obtained for the copy and the payment is processed using that

information (column 6, line 58-column 7, line 15 of Adamske).

Regarding dependent claim 27, Adamske discloses a method in which the print

driver generates the print file and an upload manager communicates the file to the

server (column 5, line 64-column 7, line 15 of Adamske).

Regarding independent claim 29, Adamske discloses a method in which a user

uses software on a client device to generate a print file based on a document and a

preview is generated from the file (column 5, line 64-column 7, line 15 of Adamske).

The user then uploads the print file and configuration information to the server, at which

point the document is printed and assembled based on configuration and style options

(column 5, line 64-column 7, line 15 of Adamske). Adamske does not directly disclose a

method in which a preview is generated by the server and provided to the user based

on the print file that was uploaded. However, Adamske discloses an alternate method

in which the server generates the print file and then from that print file and the

configuration information provided the server generates and provides a preview to the

user (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to

one of ordinary skill in the art to combine the two methods of Adamske because it would

have allowed the client system to do less work in the process.

Regarding dependent claim 30, Adamske discloses a method in which the

document may be generated on the client and obtained from the client (column 5, line

64-column 7, line 15 of Adamske).

Regarding independent claim 31, Adamske discloses a method in which a print

file based on a document is uploaded to a server along with configuration information

for the document (column 5, line 64-column 7, line 15 of Adamske). A plurality of copies

is printed in accordance with a plurality of addresses that are obtained from the user

(column 5, line 64-column 7, line 15 of Adamske). A coversheet (memo) is customized

for each address and recipient is printed; at point all parts are delivered to the delivery

addresses (column 7, lines 16-56 of Adamske). Adamske does not disclose that the

customized memo is obtained from the client. However, it would have been obvious to

one of ordinary skill in the art at the time the invention was made to have allowed the

user to create the custom memo on the client rather than the server because it would

have provided the user with more freedom of customization with the memo.

5.   Claim 28 remains rejected under 35 U.S.C. 103(a) as being unpatentable over

Adamske et al. (US Patent Number 6,625,234, filed on May 11, 1999) in view of

Bresnan et al. (US Patent Number 5,873,073, issued on February 16, 1999 - IDS).

Regarding dependent claim 28, Adamske discloses a method in which the

server generates the print file and then from that print file and the configuration

information provided the server generates and provides a preview to the user (column

5, line 64-column 7, line 15 of Adamske). Adamske also discloses a method in which a

user interface is generated that may be web based (on the server) (column 2, lines 4-60

of Adamske). The interface provides a preview section and a printing options section

that allows a user to provide configuration information (i.e. style options) (column 5, line

64-column 7, line 15 of Adamske). The interface is provided to the user via the Internet

for display (column 2, lines 4-60 of Adamske). Adamske also discloses a method in

which styles and printing options for the document are obtained and shown via the

preview that may be navigated by selecting portions (navigation area), which is then

provided to the client (column 5, line 64-column 7, line 56 of Adamske). Adamske does

not disclose a method in which an estimate area displays an estimate of price based on

the configuration and print file. However, Bresnan discloses a method in which an

estimate is generated based on configuration and the file itself and presented to the

user (column 14, lines 10-58 of Bresnan). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have combined the

methods of Adamske with the method of Bresnan because it would have allowed the

user to see the price prior to the billing process.

Response to Arguments

6.   Applicant's arguments filed 05/25/2005 have been fully considered but they are

not persuasive.

Applicant's arguments on pages 10-15, regarding independent claim 12 and the

combination of the teachings of the two embodiments of Adamske, the examiner

believes that in combination the two embodiments properly teaches all of the limitations

of the independent claims in question. In the first embodiment cited Adamske teaches

that software used on the client can be used to generate a print file and configuring file

for the print job, at which point this information is forwarded to the server (column 6,

lines 24-57 of Adamske). The other cited embodiment of Adamske disclose server may

create a preview version of the document to be displayed on the client if the server has

the print file and configuration information (column 6, lines 12-23 of Adamske). The

combination of these teachings would have made it obvious that if you have the power

to generate the print file and configuration file at the client and forward it to the server,

and the power to generate a preview at the server if you have the configuration file and

print file at the server, that you could forward the two files as taught in the first

discussed embodiment and then use them to create the preview. This would have been

obvious because it would reduce the processing load at the client.

Applicant's arguments on pages 12-15, regarding independent claim 17 and the

limitation regarding a customized memo, the examiner believes that the cited art

teaches the limitation, even as it is newly recited. Adamske discloses that the cover

sheet (memo) would include an address and the name of the actual recipient, which is

received from the client (column 17, lines 16-56 of Adamske). Since, this coversheet

would be different for each recipient, it is by definition customized.

All of the other arguments on pages 10-15 are in reference to the topics above,

thus the rationale above can be used to respond to the similar arguments.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joshua D. Campbell whose telephone number is (571)

272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JDC
September 20, 2005

STEPHEN HONG
SUPERVISORY PATENT EXAMINER